



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------------|------------------|
| 10/800,185 | 03/12/2004 | Hernando Brieva | Rev 94-18 div 8 | 8610 |
| 7590 | 01/11/2005 | | | |
| Revlon Consumer Products Corporation 237 Park Avenue New York, NY 10017 | | | EXAMINER GEORGE, KONATA M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1616 | |
| DATE MAILED: 01/11/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/800,185

Applicant(s)

BRIEVA ET AL.

Examiner

Konata M. George

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 20-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claims 20-33 are pending in this application.

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on March 12, 2004 was noted and the submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner has considered the information disclosure statement.

Priority

2. An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 1616

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 20, 23, 24 and 29-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 9, 18 and 19 of U.S. Patent No. 5,800,816. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the patent and the application disclose compositions comprising trimethylated silica, a volatile solvent (i.e. a linear silicone), a nonvolatile oil and a cosmetically acceptable carrier. The difference between the patent and the application is the addition of particulate matter comprised of pigments and powders. It is the position of the examiner that the addition of particulate matter comprised of pigments and powders would have been obvious to one of ordinary skill in the art. Since the application provides uses of the composition for lipstick, foundation makeup, eyeshadow, mascara, etc., it would have been obvious to one skilled in the cosmetic arts to add pigments or powders to the composition in the formulation of eyeshadows, lipsticks and mascara. As it is known that they are key ingredients in their composition.

4. Claims 20, 23, 25, 27 and 28-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 8 and 10 of U.S. Patent No. 5,965,112. Although the conflicting claims are not identical, they are

Art Unit: 1616

not patentably distinct from each other because the patent and the application disclose compositions comprising trimethylated silica, a volatile solvent (i.e. a linear silicone), a nonvolatile oil and a cosmetically acceptable carrier. The patent and the applicant also disclose the use of fluorinated oils as a nonvolatile oil. The difference between the patent and the application is the addition of particulate matter comprised of pigments and powders. It is the position of the examiner that the addition of particulate matter comprised of pigments and powders would have been obvious to one of ordinary skill in the art. Since the application provides uses of the composition for lipstick, foundation makeup, eyeshadow, mascara, etc., it would have been obvious to one skilled in the cosmetic arts to add pigments or powders to the composition in the formulation of eyeshadows, lipsticks and mascara. As it is known that they are key ingredients in their composition.

5. Claims 20, 23-26 and 29-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 7-9 of U.S. Patent No. 6,464,964 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the patent and the application disclose compositions comprising trimethylated silica, a volatile solvent (i.e. a linear silicone) and a nonvolatile oil. The difference between the patent and the application is the addition of particulate matter comprised of pigments and powders in the patent and the addition of a cosmetically acceptable carrier in the application. The specification of the application defines the carrier as a lipstick, eyeshadow, etc., and since the composition

of the patent is in the form of application to lips or skin, then the composition of the patent contains a carrier. It is the position of the examiner that the addition of particulate matter comprised of pigments and powders would have been obvious to one of ordinary skill in the art. Since the application provides uses of the composition for lipstick, foundation makeup, eyeshadow, mascara, etc., it would have been obvious to one skilled in the cosmetic arts to add pigments or powders to the composition in the formulation of eyeshadows, lipsticks and mascara. As it is known that they are key ingredients in their composition.

6. Claims 20-26 and 29-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 11 and 13 of U.S. Patent No. 6,780,422 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the patent and the application disclose compositions comprising trimethylated silica, a volatile solvent and a nonvolatile oil. The difference between the patent and the application is the addition of film former in the patent and a cosmetically acceptable carrier in the application. It is the position of the examiner that the addition of a film former in the composition would have been obvious to one of ordinary skill in the cosmetic art in the formulation of lipsticks, eyeshadows, mascara, etc. The carrier as defined in the specification of the application is nothing more than an eyeshadow, lipstick, etc. therefore, the use of the composition of the patent as a cosmetic can be defined as a cosmetically acceptable carrier.

Conclusion

7. Claims 20-33 are rejected.

Telephone Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Konata M. George, whose telephone number is (571) 272-0613. The examiner can normally be reached from 8AM to 6:30PM Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (571) 272-0887. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Konata M. George


SHELLEY A. DODSON
PRIMARY EXAMINER